

REMARKS

Upon entry of the present amendment claims 1-22, as amended, remain in the application;

At the outset, applicant's attorney wishes to thank the Examiner for the courtesies extended during the recent telephone conversation regarding this application and the art being applied hereagainst.

The above identified Office Action has been reviewed and the references carefully considered. In view thereof, and the matters discussed during the interview the present amendment is submitted. It is respectfully contended that by the present amendment all bases of rejection set forth in the Office Action are traversed and overcome. Accordingly, reconsideration and withdrawal of the rejection and/or entry of this amendment for purposes of possible appeal is respectfully requested.

Initially, it is to be noted that appended hereto is an affidavit submitted under Rule 132 provided by the inventor, Edward B. Kollin who, having the requisite expertise, provides the reasons why the present invention is not taught by the references being applied herein.

As pointed out in the affidavit, as well as during the interview, the key to the present invention is the initial viscosity of the lubricant and the fact that after temporary shear thinning the composition returns to substantially its initial starting viscosity. This renders the present invention distinct from any of the lubricants or lubricant compositions being cited hereagainst.

Furthermore, as discussed with the Examiner, claims 1-11, the composition claims have been amended to conform to Jepson format to clearly define the lubricant compositions as those for a run-flat tire.

For these reasons and the reasons set forth hereinafter it is submitted that the present invention has now been rendered patently distinct from the art of record.

Initially in paragraph 3 of the Office Action, the Examiner rejected claims 1-8 under 35 U.S.C. 102 (b) or under 35 U.S.C. 103 (a) as obvious over Fricke, newly cited.

As pointed out to the Examiner and as the Examiner concedes, in the Office Action, Fricke does not teach, disclose or suggest any starting viscosity for the carrier fluid for the lubricant thereof.

The reference teaches a combination of a glycol ether and a soap. Such compositions do not shear thin and then recover to the initial starting viscosity. According to Fricke, the tire collapses onto the metal rim. The metal then provides a heat sink and therefore there is no concern for temporary shear thinning. Furthermore, there is no interface between the tire support ring interface and the outer surface of the tire carcass. Again, because of Fricke's failure to expressly describe the viscosity and shear thinning of the composition it does not, teach, disclose or suggest the invention and, therefore, it is submitted that this reference does not render obvious the present invention.

As noted Fricke does not describe viscosity nor shear thinning characteristics. In order for there to be an anticipation under 35 U.S.C. 102(b) it is incumbent that the alleged anticipating reference teach and every element of the invention as claimed. Here, admittedly the reference fails in this regard. Furthermore, since this reference is a foreign language reference such reference must be taken within its four corners and cannot be expanded upon to encompass the teachings hereof.

In paragraph 4 of the Office Action claims 1-4 and 8 stand rejected under 35 U.S.C. 102(b) or under 35 U.S.C. 103(a) as being obvious over Matzat. Again, applicant respectfully traverses this rejection and requests withdrawal thereof. The Examiner concedes that Matzat does not describe the viscosity or shear thinning characteristics of the composition, but concludes it would have been obvious to one of ordinary skill in the art achieve the present invention. For the reasons noted above it is submitted that the Examiner is in error. First, Matzat is a conveyor lubricant and includes a rubber belt and a metal support to be lubricated. Since the metal acts as a heat sink the lubricant does not undergo shear thinning for temporary liquefaction. If the present product with its described properties would it be used in a conveyor, gravity and inertia would cause it to quickly flow out from the areas needing lubrication and collect in the adjoining areas where there is no shear or need for lubrication. Here, the run-flat inertia and the physical dimensions of the tire capture the fluid. Furthermore, as noted the claims have been amended to limit the application of the present composition to that of a run-flat tire. Also, Matzat is a foreign reference and must be taken within its four corners. It should

be noted that in the translation provided by the Examiner, it states that "...used to lubricate conveyor belts and has a high viscosity at high temps so that it does not become too flowable which is undesirable." The compositions hereof must undergo shear thinning in a run-flat situation, i.e. flowable. Thus, the reference is the antithesis of what is sought herein.

In paragraph 5 of the Office Action claims 6 and 7 stand rejected under 35 U.S.C. 103 as being unpatentable over Fricke and further review of either Jones '638 or Fahl '795. Applicant respectfully traverses this rejection and requests withdrawal thereof. It is submitted that neither Jones or Fahl provide the deficiencies to the primary reference that would be prerequisite to negate patentability herein. First and foremost, as noted hereinabove, by virtue of the amendment to the claims, the present composition is limited to that for a run-flat tire system. Neither Jones nor Fahl even remotely suggest incorporation of their inventions into a lubricant for a run-flat tire. The Jones reference is a grease which incorporates a phenothiazine inhibitor for improved storage stability, concomitant with desirable high temperature lubricating properties. There is absolutely no suggestion of a lubricant composition which undergoes temporary shear thinning and then returns to its original viscosity. As to Fahl this is a lubricant for water fittings. There is simply no teaching or suggestion to incorporate the inventions thereof into Fricke. Even assuming arguendo that this could be done it still is not the present invention for the reasons pointed out hereinabove. Accordingly, it is respectfully requested that this rejection be withdrawn.

In paragraph 6 of the Office Action claims 9 and 10 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Fricke in view of Lentsch. As pointed out hereinabove and in a previous amendment, Lentsch is directed to a detergent composition. One of ordinary skill in the art simply would have no motivation to look to the art of detergents to find solutions to lubricants for run-flat tires. Furthermore, the deficiencies of Fricke have been shown hereinabove and the combination of Fricke in view of Lentsch simply is not the present invention. Accordingly, it is respectfully requested that this rejection be withdrawn.

In paragraph 7 of the Office Action claim 11 is rejected over Fricke in view of either Jones or Fahl and further in view of Lentsch. At this point it is suggested that the none of the references even remotely suggest the lubricant with the viscosity and the shear thin properties hereof. Furthermore, it is submitted that the Examiner has chosen selected components from these references and employed reconstructive hindsight while overlooking the purposes to which the secondary references are directed. However, in no event can these references, whether taken singly or in combination, teach, disclose or suggest a lubricant for a run-flat tire having a minimum viscosity as disclosed and wherein the lubricant returns to substantially its initial starting viscosity after shear has stopped. Accordingly, it is respectfully requested that this rejection be withdrawn.

Next, in paragraph 8 claims 12,16 and 19 of the Office Action are rejected under 35 U.S.C. 103 (a) as being unpatentable over the admitted prior art and further in view of Fricke. The Examiner contends that Fricke discloses a lubricant

composition between a tire inner surface and a rim. As pointed out hereinabove such a teaching is not applicable to the run-flat system. In Fricke, the rim presents a heat sink and, therefore, the system is not dependent on a lubricant for preventing heat-related failures. The lubricant of Fricke simply does not depend on temporary shear thinning and does not present the tire support ring interface with a liquid. In order to be efficacious the lubricant must liquefy by temporary shear thinning and must revert, in the absence of shear, to a thickened state to the approximate starting viscosity. Moreover, the lubricant must not permanently shear as the liquid in the tire would run out a puncture hole in the tread area. Furthermore, once sheared it must be of low enough viscosity as to not allow heat buildup due to viscometric, internal molecular friction. As is known to those skilled in the art to which the present invention pertains, in the run-flat mode, the support ring and the larger diameter inter-tire surface move in relation to each other in a sliding motion providing shear stress and also a high frequency squirming motion. These motions necessitate the need for the liquefaction of the lubricant. Fricke is totally silent with respect to any lubricant having the properties hereof because of the absence of any teaching of any molecular weights, nor does it even suggest such a composition. Thus, in all instances, Fricke fails to render obvious the invention set forth in claims 12-16 and 19 and, accordingly, it is respectfully requested that this rejection be withdrawn.

Next, in paragraph 9 of the Office Action claims 17 and 18 stand rejected under 35 U.S.C. 103 (a) as being unpatentable over the admitted state of the prior

art and Fricke and further in view of either one of Jones or Fahl. As pointed out hereinabove Jones or Fahl simply fail to provide the deficiencies to Fricke which would be prerequisite to negate patentability herein. Applying and incorporating the teachings of either Jones or Fahl, (assuming that such could be done) there would be provided a lubricant having a phenothiazole incorporated therewithin as well as a complexing agent and a hydrofoaming agent which could then be used in a water fitting. The teachings are totally inapposite since Fricke in no way suggests that the lubricant thereof could be used for a water fitting. Thus, it is submitted that the rejection is in error and it is requested that this rejection be withdrawn.

In paragraph 10 of the Office Action claims 20 and 21 stand rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted state of the prior art and Fricke in further in view of Lentsch. Applicant respectfully traverses this rejection and requests withdrawal thereof. For the same reasons submitted hereinabove it is submitted that Lentsch that is totally inapplicable hereto. Lentsch is a detergent, not a lubricant and simply does not provide the deficiencies to Fricke which would be prerequisite to negate patentability herein. There simply is no suggestion in the art that one of ordinary skill in the art would look to the detergent art for surfactant. Thus, it is submitted that the rejection is in error and withdrawal thereof is respectfully requested.

In paragraph 11 of the Office Action claim 22 stands rejected under 35 U.S.C. 103 (a) as being unpatenable over APA and Fricke as applied in claim 12 above in view of either one of Jones or Fahl and further in view of Lentsch. Again, it

submitted that the Examiner is taking piecemeal portions of these references in an attempt to negate patentability herein. This is totally improper. The Examiner cannot properly avoid the teachings to which the inventions of these secondary references are directed. Jones or Fahl simply have no applicability to a run-flat tire and Lentsch is even more remote therefrom. Accordingly, it is respectfully requested that this rejection be withdrawn.

In paragraph 12 of the Office Action claims 5-7 stand rejected under 35 U.S.C. 103 (b) as being unpatentable over Matzat and further in view of either one of Jones or Fahl. The same arguments urged above apply equally here. Matzat simply fails to teach, disclose or suggest a lubricant of the prerequisite viscosity with the inherent property of returning to substantially its initial viscosity. Furthermore, the Matzat references does not even remotely apply to a run-flat tire, nor address the needs of a run-flat tire.

For the reasons pointed out hereinabove, Jones or Fahl simply do not provide the deficiencies to Matzat which would be prerequisite to negate the patentability of the instant invention, especially since the claims are now in Japson form.

Furthermore, and in this regard the same comments apply equally to the rejection of claims 9 and 10 over Matzat and further in view of Lentsch. Similarly, with respect to claim 11 the combination of Matzat in view of one of either Jones or Fahl and further in view of Lentsch simply fails to teach the present invention. Accordingly, it is respectfully requested that the rejection of claims 5-7, 9, 10 and 11 be withdrawn.

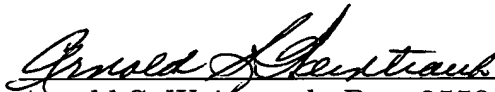
Next, in paragraph 15 of the Office Action claims 1,2 and 4-8 now stand rejected under 35 U.S.C. 103(a) as being unpatentable over Wavin and further in view of O'Bryant '248. Applicant respectfully traverses this rejection and requests withdrawal thereof. First and foremost Wavin is directed to a lubricant composition for spigot and socket joints in pipes and which contain a water-miscible compound. The reference does not teach any viscosities nor does it teach the concept of being capable of undergoing shear and returning to its original or substantially original viscosity. Such factors are present in the claims and overcome any rejection based upon Wavin. Accordingly, it is respectfully requested that this rejection be withdrawn.

CONCLUSION

It is respectfully submitted that in view of what has been set forth herein and in light of the affidavit and the telephone interview that the present application has placed this application in condition for allowance. A notice to this effect is, therefore, respectfully requested.

If the Examiner feels that the prosecution of this application can be expedited then he is courteously requested to place a telephone call to the applicants attorney at the number listed below.

Respectfully submitted,



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Dated:

